

Remarks/Arguments

The Examiner issued a Restriction between eleven species associated with the invention set forth in the claims of Group I. However, this species restriction is improper for at least three reasons, as set forth below. Thus, this species election is made with traverse.

First, many claims recite multiple species, and thus, the claims restricted to different species cannot be mutually exclusive. According to § 806.04(f) of the Manual of Patent Examining Procedure (MPEP), "[c]laims to be restricted to different species must be mutually exclusive." However, in this case, the species enumerated by the Examiner are not mutually exclusive. In other words, it is possible for two species to co-exist. For example, claim 3 recites first constituents (species I-a), metal atoms (species I-b), and linking units (species I-c). Since the species themselves are not mutually exclusive, it is possible for the claims to embody more than one species. Thus, the claims to be restricted to different species cannot be mutually exclusive, and subsequently, the restriction is improper.

Second, the species restriction is improper because it does not provide for a generic claim. A species restriction is only proper where there is at least one generic claim. As set forth in 37 CFR 1.146, "[i]n the first action on an application *containing a generic claim* to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted if no claim to the genus is found to be allowable." Further, since claims to be restricted to different species must be mutually exclusive, as explained above, a generic claim cannot recite any species.

In this case, claim 1 has to be generic. Since claim 1 is the only independent claim in the elected Group I, it is, by definition, the broadest claim. Further, since a species restriction requires at least one generic claim which is broad enough to embrace all of the species, the broadest claim must be generic. Accordingly, since claim 1 is the broadest claim, by definition, in the elected Group I, claim 1 must be a generic claim.

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However, claim 1 is not generic in this case because it recites at least two species. Namely, claim 1 recites both "first constituents," which is the subject matter of species I-a, and "metal atoms," which is the subject matter of species I-b. Since requiring a restriction between "first constituents" and "metal atoms" abrogates the generic claim requirement under 37 CFR 1.146, the restriction must be improper.

Third, since claim 1 recites two species, it is impossible to elect a subset of claims if either of those species is elected. In this case, claim 1 is the only independent claim in the elected group of claims. Since all of the claims depend there from, all of the claims impart the limitations set forth in claim 1. Thus, since independent claim 1 recites both first constituents (species I-a) and metal atoms (species I-b), all of the claims can be included in species I-a and species I-b. Thus, if the Applicant elects either species I-a or species I-b, then the Applicant would be entitled to consideration of all of the claims. Since all of the claims are included in species I-a or species I-b, the restriction between at least species I-a and I-b is improper.

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In light of the three reasons set forth above, the Applicants assert that the restriction requirement is improper. However, to be responsive, the Applicant hereby elects species I-a directed to first constituents. By this election, the Applicants assert that they are entitled to consideration of all of the claims, since the independent claim recites the first constituents, as explained above. Alternatively, the Applicants point out that only the following claims in the elected group I expressly state "first constituents": claims 1, 10, 14-25, 27-29, 52-59, 61-64, 74-76, 81, 83-85, and 88.

In an attempt to resolve the problems associated with the species restriction set forth above, Ralph A. Dowell contacted Examiner Kugel via telephone on August 14, 2006. During the conversation, Examiner Kugel indicated that "the species requirement was a request for an election of one species for each of I-a through I-k (11 species) not a request to elect between species I-a through I-k (one species)." However, the Examiner has not set forth any "sub-species" for any of the eleven species, I-a through I-k. Since there are no "sub-species" to elect, it is impossible for the Applicants to make such a "sub-species" election. Since the Applicants have made an election with traverse among the eleven species set forth by the Examiner

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in the Office Action, the Applicants respectfully assert that this communication is fully responsive to the restriction requirement set forth in the Office Action.

Lastly, the Applicants believe that this response has been timely filed and thus, no extension of time fees are due. As set forth in Office Action, "a shortened statutory period for reply is set to expire 3 months or thirty days, whichever is longer, from the mailing date of this communication." Since the Office Action was mailed on June 22, 2006, this response is timely filed within three months of the mailing date. However, if any extension of time fees are due, they may be charged against deposit account no. 04-1577.

Respectfully submitted,

DOWELL & DOWELL, P.C.

By 

Ralph A. Dowell, Reg. No. 26,868

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DOWELL & DOWELL, P.C.
Suite 406, 2111 Eisenhower Ave.
Alexandria, VA 22314
Telephone - 703 415-2555
Facsimile - 703 415-2559
E-mail - dowell@dowellpc.com